

Remarks

Claim 15 has been amended to further clarify that recording the disc based on the job involves the medical data image viewing software being recorded on the disc along with the medical data. Claims 1-14, 17, 19-24, 33, and 34 were previously canceled. Claims 15, 16, 18, 25-32 remain pending in the application.

Wright '164 Reference Is Not Prior Art

In the latest Office Action, US Patent No. 7,302,164 to Wright et al. (Wright '164) was used in 35 USC 102(e) and 35 USC 103(a) rejections of the presently pending claims 15, 16, 18, 25-32. The Applicant respectfully points out that the filing date of Wright '164 is January 17, 2001. This date is two weeks later than the instant application's filing date of January 2, 2001. As such with the later filing date, the Wright '164 patent is not actually prior art under 35 USC 102(e) or 35 USC 103(a) and any rejection of the pending claims based on this reference must be withdrawn.

Under certain circumstances a later-filed application for patent is entitled to the benefit of the filing date of a prior-filed provisional application which has at least one common inventor. The conditions are specified in 35 U.S.C. 119(e) and 37 CFR 1.78(a)(4) - (a)(6) for the benefit claim of a prior provisional application. In this case, the Wright '164 patent claims priority to a provisional patent application having Application No. 60/181,985 which was filed on Feb. 11, 2000 (Wright '185).

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior provisional application. In other words, the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See Transco Prods., Inc. v. Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). See also, 37 CFR 1.78(a)(1). Accordingly, the disclosure of the prior-filed application must provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. 112, first paragraph. In New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional

application to be afforded the priority date of the provisional application, "the specification of the provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 ¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application."

In this case, the provisional patent application Wright '185 patent application fails to disclose several of the features relied upon by the Examiner in rejecting the presently pending claims. In particular, the Wright '185 patent application appears to contain a description of some other concept identified as a "DatCard" personal medical records card that is a credit card sized CD containing a patient medical record data, insurance information and a power of attorney. Towards the end of the Wright '185 application, a reference is made to a "CopyDat" application that is intended to imbed medical images on a credit card size CD in DICOM format along with a DICOM image viewer. The description in the Wright '185 application amounts to a wish list of features for a system with little or no technical information about how to make such a system. More precisely, the description is not adequate enough to enable one of ordinary skill in the art at the time of this application to make such a system (i.e., practice such an invention). In one passage the text of the Wright '185 application clearly indicates it is not an enabling disclosure when it states

"DICOM is a complex animal and its development is better left to the experts in the DICOM world. We should not reinvent the wheel. We will research a number of commercially available DICOM Store tool sets allowing the workstation to provide DICOM SCP facilities."

In short, the Wright '185 application admits that it does not know how to make the proposed device with the wish list of features. Wright '185 simply lacks an adequate written description under 35 U.S.C. § 112, ¶1.

Furthermore, the Wright '185 application does not even mention several features of the present invention as claimed in independent claim 15. In particular, the Wright '185 application does not teach or describe at least the following:

1. Parsing patient identification information and study information from the received medical data.
2. Noting the end of the received medical data through the software module for each patient.
3. Creating a job containing a print file for an autoloader control software where the print file includes the stored parsed patient identification information and the stored parsed study information.

For the foregoing reasons, Wright '164 is not entitled to claim the priority date of the related Wright '185 provisional application for the features utilized in the current 35 USC 102(e) and 35 USC 103(a) rejections of the presently pending claims. Thus, the Wright '164 patent is not actually prior art under 35 USC 102(e) or 35 USC 103(a) and any rejection of the pending claims based on this reference must be withdrawn.

35 U.S.C. §102 and 35 U.S.C. §103 Rejections Based on Wright '164 Reference

Even if the rejections of pending claims 15, 16, 18, 25-32 under 35 USC 102(e) or 35 USC 103(a) based on the Wright '164 reference are not withdrawn, the Wright '164 reference does not teach or describe at least the following:

1. Parsing patient identification information and study information from the received medical data.
2. Noting the end of the received medical data through the software module for each patient.
3. Creating a job containing a print file for an autoloader control software where the print file includes the stored parsed patient identification information and the stored parsed study information.

In reference to parsing patient identification information and study information from the received medical data, Wright '164, column 5, lines 50-60 is identified as teaching this feature. However, this passage actually mentions an input image device name/ID that

indicates an origin of the received data. That ID is subsequently used to find a profile record. At no point, is the parsing of patient identification and study information from the received data mentioned.

Further in reference to noting the end of the received medical data through the software module for each patient, Wright '164, column 5, lines 20-50 is identified as teaching this feature. However, this passage actually mentions monitoring changes in an image server database. This passage does not mention associating this change with data received with a particular patient.

Furthermore in reference to creating a job containing a print file that includes the stored parsed patient identification information and the stored parsed study information, Wright '164, column 6, lines 4-67 and column 7, lines 1-20 is identified as teaching this feature. While this passage mentions a label printing file includes the patient name and exam modality as well as other study information, it does not mention where this label information comes from. In particular, there is no mention of using information on the label that was originally parsed from received medical image data file.

Thus, Wright '164 does not teach or suggest at least these features of the system now claimed in independent claim 15. Similarly, U.S. Patent No. 5,717,841 by Farrell et al. does not teach or suggest at least these same features now claimed in independent claim 15. Furthermore, claims 16, 18 and 25-32 depend from claim 15 and therefore are allowable over the Wright '164 alone or in combination with Farrell et al. for the same reasons that claim 15 is allowable. Therefore, under 35 USC 102(e) and 35 USC 103(a) based on the Wright '164 alone or in combination with Farrell et al, fails to teach the present invention as claimed in claims 15, 16, 18 and 25-32 and withdrawal of these rejections is respectfully requested.

35 U.S.C. §103

Claims 15, 16, 18, 26 and 29-32 stand rejected under 35 USC 103(a) as being unpatentable over Pelanek, U.S. Patent No. 5,724,582 (Pelanek) in view of Kahle, U.S. Patent No. 5,518,325 (Kahle) and further in view of Murray et al., U.S. Patent No. 5,721,891 (Murray).

Applicant respectfully disagrees with the Examiner's characterization in Pelanek of a file directory on a CD as being equivalent to recording medical data viewing software on the disc. As previously explained, claim 15 describes recording on the disc both medical data and viewing software. In the interest of facilitating examination and allowance of the pending claims, the language of claim 15 has been amended to further clarify that the recording step records a disc such that the medical data is recorded on the disc along with medical data image viewing software. As previously acknowledged by the Examiner this feature is not taught or suggested by Pelanek.

Applicant agrees with the Examiner that Pelanek does not teach creating a job containing a print file for autoloader control software where the print file has the stored parsed patient identification information and the stored parsed study information. Kahle is cited as teaching disk label printing. The Applicant agrees that Kahle generally describes disk labeling, but Kahle does not mention a need or desire to work with medical records or any special needs on labeling disks when working with medical records. Neither Pelanek nor Kahle teach that the source of the data printed on the disc includes parsed patient identification information and parsed study information as claimed in claim 15. The Examiner asserts that it would have been obvious to do so. This is a rather curious assertion, because Pelanek does not mention the desire to label a disk and Kahle does not mention what is desirable to be put on a label let alone where the source data for the label is from.

Applicant agrees with the Examiner that Pelanek does not teach noting the end of the received medical data through the software module for each patient. Murray is cited as teaching a timer to detect the end of a transmitted data stream. The Applicant agrees that Murray generally describes timers and detecting ends of transmitted streams, but Murray does not mention a need or desire to work with medical records or associating the end of data streams with a patient. The Examiner asserts that it would have been obvious to do so.

Overall the assertion of obviousness with respect to claim 15 from disparate and non-analogous technical arts appears to take into account more knowledge than what was

within the level of ordinary skill in the art at the time the claimed invention was made, and appears to include additional knowledge gleaned only from the Applicant's disclosure (i.e., improper use of hindsight). The Applicant respectfully points out that the references must, at a minimum, either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. It does not appear as if that is the case with Pelanek, Kahle, and Murray. Further, the gaps in the teachings between these references simply can not be bridged by common sense alone. The gist of the present invention as claimed lies within these gaps, including but not limited to, the unique combination of features of a method for recording medical data on a disc. As such, this obviousness rejection of claim 15 is flawed and must be withdrawn.

Claims 16, 18, 26, and 29-32 depend from claim 15 and therefore are allowable over the Pelanek, Kahle, and Murray for the same reasons that claim 15 is allowable.

In summary, the Pelanek, Kahle, and Murray fail to teach at least two features described in pending independent claim 15. These two features are: (1) printing a template with parsed information to label the disc where the parsed information is patient identification information and study information parsed from received medical data; and (2) recording a disc with the data produced by the job where the job contains medical data and medical data image viewing software. Therefore, under 35 USC 103(a), the Pelanek, Kahle, and Murray, alone or in combination with one another, fail to teach the present invention as claimed in claims 15, 16, 18, 26, and 29-32 and withdrawal of this rejection is respectfully requested.

Claims 27-28 stand rejected under 35 USC 103(a) as being unpatentable over Pelanek, in view of Kahle and further in view of Murray et al. and further in view of U.S. Patent No. 5,717,841 by Farrell et al. (Farrell). Farrell, like Pelanek, Kahle, and Murray, does not teach or suggest at least the features described above in independent claim 15 and dependent claim 26. Claims 27-28 are dependent on claims 15 and 26 and therefore are allowable over the Farrell for the same reasons that claims 15 and 26 are allowable.

Claim 25 stands rejected under 35 USC 103(a) as being unpatentable over Pelanek, in view of Kahle and further in view of Murray et al. and further in view of U.S. Patent No.

5,721,891 by Koritzinsky et al. (Koritzinsky). Koritzinsky, like Pelanek, Kahle, and Murray, does not teach or suggest at least the features described above in independent claim 15. Claim 25 is dependent on claim 15 and therefore is allowable over the Koritzinsky for the same reasons that claim 15 is allowable.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 15, 16, 18, 25-32 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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